

REMARKS

I. Overview

These remarks are set forth in response to the Non-Final Office Action mailed February 21, 2007. As this amendment has been timely filed within the three-month statutory period, neither an extension of time nor a fee is required. Presently, claims 1 through 13 are pending in the Patent Application. Claims 1, 5, 9 and 13 are independent in nature. In the Non-Final Office Action, each of claims 1-13 have been rejected under 35 U.S.C. § 101. Additionally, claims 1 through 13 have been rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent Publication No. 2001/0028364 by Fredell et al. (Fredell).

II. The Applicant's Invention

The Applicants have invented a system, method and apparatus for the management of external data sources in a discussion resource forum. In the Applicants' invention, a discussion forum resource can be provided in which collaborators can post messages for viewing by other authorized collaborators. The posted messages can include text, audio, imagery or any combination thereof. The posted messages can be posted in a single topic thread, or across multiple topic threads in the discussion forum resource.

Importantly, the discussion resource forum can be configured to incorporate externally sourced data or addressable links to externally sourced data, such as Web sites, remotely disposed media files, data from news groups, or even the postings of other discussion forums. Additionally, to the extent that the external source permits, postings

relating to the externally sourced data can be provided to the external source for posting therein. More specifically, where the external source is an externally disposed discussion forum, postings relating to the externally sourced data can be posted in the externally disposed discussion forum.

III. Amended Claims

Applicants have cancelled claim 3 and have amended claims 1, 4, 5, 9 and 13 to highlight the incorporation of external postings in one discussion forum resource sourced from another discussion forum resource and the responsive posting from the one discussion forum resource to the other discussion forum resource. The amendments to the claims are expressly supported by paragraphs [0019] of the Applicants' specification. Accordingly, no new matter has been added.

IV. Rejection Under 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1 through 13, are directed to non-statutory subject matter. This rejection is respectfully traversed. In *State Street Bank and Trust Company v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed Cir. 1998), the court set forth the criteria for establishing statutory subject matter under 35 U.S.C. § 101 as follows:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to —process, machine, manufacture, or composition of matter—but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure

and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994). For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a "useful, concrete, and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.

Thus, as articulated above, the test for determining whether subject matter is patentable under 35 U.S.C. § 101 involves deciding if the subject matter produces a "useful, concrete, and tangible result."

A discussion of the procedural considerations regarding a rejection based upon lack of utility (i.e., 35 U.S.C. § 101) is found in M.P.E.P. § 2107.02. Specifically, M.P.E.P. § 2107.02(I) states that:

regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112

In paragraph [0017] of Applicants' disclosure, it is stated that in the invention as claimed in claims 1, 5, 9 and 13, where an external source of externally sourced data in one discussion resource forum is another externally disposed discussion forum, postings relating to the externally sourced data can be posted in the other, externally disposed discussion forum. The Applicant, therefore, has asserted a credible utility. As noted in M.P.E.P. § 2107.02(III)(A), the Court of Customs and Patent Appeals in *In re Langer* stated the following:

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope. (emphasis in original)

Since a credible utility is contained in Applicants' specification, the utility requirement of 35 U.S.C. § 101 (i.e., whether the invention produces a useful, concrete, and tangible

result) has been met. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-13 under 35 U.S.C. § 101.

V. Rejections Under 35 U.S.C. § 102(b)

A. Characterization of Fredell

Fredell discloses a secure web-based method and system for communicating and managing project information. The Fredell method as described allows for storing project-related information including project documentation in a database. The Fredell method further provides an interface screen available through a global communications network that is configurable to identify project tasks and includes a datafield for defining a respective time window over which each of the tasks is to be performed by at least one project participant. The Fredell method allows for posting the project tasks over the global communications network to selected project participants. The posted project tasks are linkable to the database to retrieve project documentation that requires review by the selected project participants.

B. Traversal of the Rejections on the Art

Applicant's amended independent claims require the receipt of externally sourced data for posting in one discussion forum resource, the creation of a new topic thread for the externally sourced data, and the responsive posting to the externally sourced data in the new topic thread. Though Fredell clearly shows the presence of a "discussion forum" in Figure 6 and paragraph [0108] of Fredell, there is no teaching anywhere within Fredell that a new topic thread is created for externally sourced data as required by the plain

claim language of amended claims 5 and 9. Additionally, while Fredell teaches the incorporation of a discussion forum, Fredell lacks any teaching directed to externally sourced content comprise postings from another discussion forum resource as expressly required by claim 1.

Finally, Fredell wholly lacks any disclosure relating to the synchronization of postings related to one another in at least two discussion forum resources as explicitly claimed in claim 13. In particular, the Applicants note that "synchronization" between two discussion resources cannot be inherent to the provision of a notification when a task is overdue as stated in paragraph [0120] and [0121] of Fredell. In fact, nowhere in Fredell is it suggested that anything about two separate discussion forums are linked in any way and it is important to note that "tasks" are not synonymous or even related to discussion forums.

VII. Conclusion

The Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §§ 101 and 102(b) owing to the amended and cancelled claims and the foregoing remarks. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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